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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/623-877 11/27/00 CARROLL

F 196838US0PCT

022850 HM22/0815  
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EXAMINER

AULAKH.C

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

08/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/623,872

Applicant(s)  
Carrol, F.I. et al.

Examiner  
Charanjit Aulakh

Art Unit  
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug. 6, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) 1-16 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Nov. 27, 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 20) ☐ Other:

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### **DETAILED ACTION**

1. According to paper no. 12, filed on Aug. 6, 2001, the applicants have elected group IV, claims 17-22 and 26 with traverse for further prosecution in response to restriction requirement. Claims 1-16 and 23-25 are withdrawn from further consideration as being drawn to non-elected inventions.

### ***Response to Arguments***

2. Applicant's arguments filed on Aug. 6, 2001 ( paper no. 12 ) regarding restriction requirement have been fully considered but they are not persuasive. The examiner does not agree with the applicants arguments that no evidence was presented. It was clearly stated as admitted by the applicants that “ There is no common core present which is shared by all of the alternatives “. Therefore, the restriction requirement as indicated is proper and thereby made final.

### ***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b).  
An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claims 17-22 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pelcman ( U.S. Patent no. 6,153,626 ).

Pelcman discloses compounds of formula (I) having high affinity for opioid receptors, pharmaceutical compositions containing these compounds and a method of treating pain using these compounds ( see claims 1-20 ). The compounds of formula (I) of Pelcman where R1 represents C1-C6 alkyl or an allyl or phenyl alkyl group, A represents benzamide group and B represents an aryl or hetroaryl group clearly anticipates the instant claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on “ Monday-Thursday “ from 7:30 A.M. to 6:00 P.M.

If the attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Ms. Jyothsna Venkat, can be reached on (703) 308-2439. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group’s receptionist whose telephone number is (703) 308-1235.

  
CHARANJIT S. AULAKH

PRIMARY EXAMINER